

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte LUC MONTAGNIER, SOLANGE CHAMARET,  
DENISE GUETARD, MARC ALIZON, FRANCOIS CLAVEL,  
MIREILLE GUYADER, PIERRE SONIGO, FRANCOISE BRUN-VEZINET,  
MARIANNE REY, CHRISTINE ROUZIOUX and CHRISTINE KATLAMA

---

Appeal No. 2001-0556  
Application No. 08/470,489

---

REMAND

---

**MAILED**

**DEC 17 2001**

**PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Before, STONER, Chief Administrative Patent Judge,  
HARKCOM, Vice Chief Administrative Patent Judge, and  
WILLIAM F. SMITH, Administrative Patent Judge.

WILLIAM F. SMITH, Administrative Patent Judge.

REMAND TO EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and take appropriate action.

The examiner entered an examiner's answer on June 19, 2000 (Paper No. 34). Therein, the examiner refers the reader to Paper No. 27 for a statement of the rejection.

Appeal No. 2001-0556  
Application No. 08/470,489

In the portion of the examiner's answer headed "Response to Argument" the examiner only states "For the above reasons, it is believed that the rejections should be sustained." The examiner's answer is manifestly improper.

Appellants are entitled to an examiner's answer which sets forth in detail why the arguments presented in the Appeal Brief are not persuasive. Furthermore, this board serves as a board of review. 35 U.S.C. § 6(b). The examiner's answer entered in this case does not allow reasoned review of the facts and reasoning relied upon by the examiner in support of the decision that the claims on appeal are unpatentable.

The Reply Brief makes note of the fact that the examiner did not respond to appellants' arguments contained in the Appeal Brief. For example, appellants state at page 4 of the Reply Brief:

In both of these instances, merely citing back to the prior Office Action does not further prosecution or better clarify the case for appeal. Appellants have presented detailed arguments that the claimed invention was fully described in the specification despite the contentions of the Examiner. Appellants' arguments addressed all of the Examiner's grounds for rejection in great detail. The Examiner has not specifically responded to these arguments, but instead has simply referred to previous general allegations. Appellants submit that the Examiner's lack of specific response to their arguments evidences the incontrovertibility of these arguments.

The examiner entered the Reply Brief without comment and forwarded the case to the Board for a decision. (Paper No. 37, October 29, 2000).

Upon return of the application, the examiner is to review all arguments presented in the Appeal Brief and the Reply Brief and prepare an appropriate communication

Appeal No. 2001-0556  
Application No. 08/470,489


setting forth the examiner's reasoned response to appellant's position on appeal. It would be particularly helpful if the examiner would also restate the rejection in that Office action instead of making reference to a previous paper. Appellants and the board should not be left to surmise and conjecture as to the examiner's position on appeal, including the examiner's response to appellant's arguments.


If otherwise appropriate, we authorize a supplemental examiner's answer under 37 CFR § 1.193 (b)(1).


This application, by virtue of its “special” status, requires an immediate action.

MPEP § 708.01(D)(Rev. 1, Feb. 2000) It is important that the board be informed promptly of any action affecting the appeal in this case.

REMANDED

  
BRUCE H. STONER, JR.  
Chief Administrative Patent Judge

  
GARY V. HARKCOM  
Vice Chief Administrative Patent Judge

  
WILLIAM F. SMITH  
Administrative Patent Judge

## BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No. 2001-0556  
Application No. 08/470,489

FINNEGAN, HENDERSON, FARABOW,  
GARRETT AND DUNNER  
1300 I STREET NW  
WASHINGTON, DC 20005-3315

vsh